



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,967	08/31/1998	RANDAL LEE BERTMAN	RP9-95-017V	4218

7590 05/21/2004

Winstead, Sechrest & Minick P.C.
5400 Renaissance Tower
1201 Elm Street
Dallas, TX 75270-2199

EXAMINER

HUYNH, BA

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 05/21/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

29

Office Action Summary	Application No.	Applicant(s)	
	09/143,967	BERTMAN ET AL.	
Examiner	Art Unit		
Ba Huynh	2173		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 38,39,45,46,50,51,57,58,62,63,69,70 and 73-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 45,46,57,58,69 and 70 is/are allowed.
- 6) Claim(s) 38,39,50,51,62,63 and 73-79 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 38, 39, 50, 51, 62, 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,666,502 (Capps) in view of US patent #5,901,246 (Hoffberg et al).

- As per claims 38, 39, 50, 51, 62, 63: Capps teaches a handheld computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, an input digitizer, a control program stored in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line 52). The system displays a form defining data fields (figure 5a) and exercises a predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a list of predicted data entries for a defined data field 184 with the top item in the list being the highest ranked data entry to be selected (figures 5b). Capps fails to teach that the defined data field is filled with the predictive default entry. It is noted that a Capps' user must select the desired entry (most desirable top-most entry) from the list to fill-in the data field. However in the same field of data entry, implementation of default entry from a predicted list of options is disclosed by Hoffberg et al (See 51:62-66; 77:55-63; 81:10-21). It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Hoffberg's implementation of default entry from a predicted list of options to Capps for automatically fill in the data field with the option that is predicted as the most probably desired option by the user. Motivation of the combining is for the improvement wherein acceptable choice can be

immediately or quickly presented to the user as suggested by Hoffberg et al (77:60-63). In light of the combining, the system stores a predictive list of entries (Capps' 11:21-31; figures 6A,B) and automatically selects a default entry from the list based on a predetermined algorithm.

2. Claims 73-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,666,502 (Capps) in view of US patent #5,901,246 (Hoffberg et al), further in view of US patent #5,805,911 (Miller)

- As for claim 73: Capps teaches a handheld computer system comprising a housing, a processor mounted within the housing for processing digital data, a memory for storing digital data, a display, an input digitizer, a control program stored in the memory for processing of digital data (figures 1, 2; col. 4, line 39 – col. 5, line 52), circuitries for displaying a form defining data fields (figure 5a) and exercises a predictive widget (9:65 – 10:32; 11:32 – 12:24) to supply a list of predicted data entries for a defined data field 184, wherein the top item in the list being the highest ranked data entry to be selected (figures 5b). Capps fails to teach that the defined data field is filled with the predictive default entry. It is noted that a Capps' user must select the desired entry (most desirable top-most entry) from the list to fill-in the data field. However in the same field of data entry, implementation of default entry from a predicted list of options is disclosed by Hoffberg et al (See 51:62-66; 77:55-63; 81:10-21). It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Hoffberg's implementation of default entry from

a predicted list of options to Capps for automatically fill in the data field with the option that is predicted as the most probably desired option by the user. Motivation of the combining is for the improvement wherein acceptable choice can be immediately or quickly presented to the user as suggested by Hoffberg et al (77:60-63). In light of the combining, the system stores a predictive list of entries (Capps' 11:21-31; figures 6A,B) and automatically selects a default entry from the list based on a predetermined algorithm.

The combined teachings fail to clearly teach the circuitry operable for predictive filling an entry in the form after the user enter one or more character in the entry field. However in the same field of providing data entry into a data field using predictive modules, Miller discloses the prediction of data entries into data fields after user has input the first few characters (1:33-41; 9:25-43. See also Capps' Background of Invention). Miller suggested that a predicted data entry can be displayed to the user for selection or can be automatically selected by default for entry into a data field (9:42-45; 12:49-61). Thus it would have been obvious to one of skill in the art, at the time the invention was made, to combine Miller's teaching of predicting the user desirable option after user input characters to a data field to the combination of Capps & Hoffberg for the advantage of having the capability to predict user desirable option from the first few characters input by the user. Such modification would supplement Capps&Hoffberg predicted list of options, for example in the case the list does not contain option desired by the user. The

modification would provide a supplement for predicting the desirable option from user input characters.

- As for claims 74, 75: An entry is selected based on weight determination of frequency and/or recency of use (11:32 12:23; figures 5, 6).
- As for claim 76: The predictive filling an entry in the form after the user enters one or more characters in the form is based on a combination of frequency and recency of data entries previously entered by the user in one or more entries in the form (Miller's 9:26-67, 11:1-27, figure 4; Capps' figures 5, 6).
- As for claim 77: The system includes circuitries for presenting the list of predicted entries to the user (Capps' figure 5; Miller's 12:58-61). The list comprises data entries previously entered by the user in one or more entries in the form (Miller's 9:26-67, 11:1-27, figure 4; Capps' figures 5, 6).
- As for claims 78, 79: The list is organized by one of a recency and/or frequency of data entries previously entered in said form (Miller's 9:26-67, 11:1-27, figure 4; Capps' 12: 4-23, figures 5, 6).

Allowable Subject Matter

3. Claims 46, 58, and 70 are allowed as set forth in the previous Office action.

Claims 45, 57 and 69 are also allowable in view of the applicant's argument that Miller and Capps do not teach selecting a data entry from the predictive list based upon a user selected weight determination of the recency and frequency of use of listed data entries.

Response to Arguments

4. Applicant's arguments with respect to claims 38, 39, 50, 51, 62, 63, 73-79 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (703) 305-9794. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone numbers for the

Art Unit: 2173

organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

Ba Huynh
Primary Examiner
Art Unit 2173
5/11/04

BAHUYNH
PRIMARY EXAMINER